

### **REMARKS**

Pursuant to the present amendment, claims 1-3, 5-6, 13, 15, 21 and 24 have been amended and claims 7-12, 19-20 and 27 have been canceled. Thus, claims 1-6, 13-18, 21-22 and 24-26 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested in view of the amendments and arguments set forth herein.

In the Office Action, the Examiner issued several formality objections regarding claims 2-3, 5-6, 13, 15 and 24. It is believed that the present amendment has addressed all of the formalities identified by the Examiner. Withdrawal of the objections is respectfully requested.

In the Office Action, claims 1, 3, 7-9, 11-14, 16, 19 and 24-27 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Xu (U.S. Patent No. 6,656,837). Claims 1-4, 7-9, 11-16, 19, 21-22, 24 and 26 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Ruelke (U.S. Patent Publication No. 2004/0084680). Claims 23 and 27 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Xu. Claim 27 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ruelke. Claims 5-6 and 17-18 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Xu in view of Tu (U.S. Patent No. 5,962,344). Claims 5-6 and 17-18 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ruelke in view of Tu. Claims 10 and 20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ruelke in view of Wu (U.S. Patent No. 6,720,256). Applicants respectfully traverse the Examiner's rejections.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency

requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgirk v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing prima facie anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35

U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

It is believed that the Examiner's anticipation rejections are moot in view of the amendments made herein. It should be understood that in making the amendments set forth herein, Applicants do not acquiesce in the appropriateness of the Examiner's rejections. Applicants specifically reserve the right to pursue claims of the scope set forth in the rejected claims in a later filed application should they desire to do so.

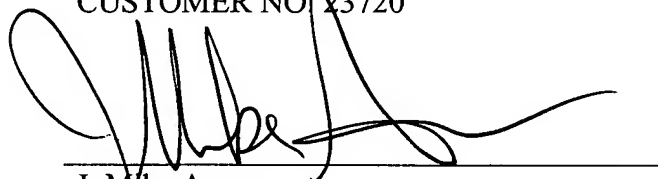
In the Office Action, dependent claims 10 and 20 were only rejected on the basis of alleged obviousness in view of Rulke. Independent claims 1, 13 and 24 have been amended to include the out-gassing step that the Examiner noted is not disclosed in Rulke. Office Action, p. 13. However, Rulke is not prior art to the present application in the context of an obviousness

analysis under 35 U.S.C. § 103. According to MPEP § 706.02(I)(1), “effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter the claimed invention ‘were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.’” The present application was filed on or after November 29, 1999. Furthermore, the present application and the Rulke patent were, at the time the present invention was made, owned by the same entity or subject to an obligation of assignment to the same entity, namely Advanced Micro Devices. Thus, Applicants respectfully submit that the Rulke patent is not available as prior art in any obviousness determination.

In view of the foregoing, it is respectfully submitted that all pending claims are allowable over the prior art of record. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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